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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,006	11/30/2000	Victor L. Vines M.D.	108747.00004	3430

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EXAMINER
MYSTER, JACQUELYN M

ART UNIT	PAPER NUMBER
2863	

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/727,006	VINES M.D., VICTOR L.	
	Examiner	Art Unit	
	Jacquelyn M. Myster	2863	

-- The MAILING DATE of this communication appears on the cover she t with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) *7-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 19-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *7-18* are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 November 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6 and 19-21 drawn to a method of using a recording device, classified in class 702, subclass 138.

II. Claims 7-15, drawn to a method of using a recording device, classified in class 702, subclass 138.

III. Claims, drawn to 16-18, classified in class 702, subclass 138. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the vacuum pressure can be recorded without storing the record of the pressure. The subcombination has separate utility such as in monitoring the pressure in a vacuum device such as a vacuum chamber.

Inventions I and III and inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this

case the apparatus as claimed can be used to practice another and materially different process such as monitoring the pressure in a device such as a vacuum chamber.

During a telephone conversation with Steven Thrasher on August 12, 2002 a provisional election was made without traverse to prosecute the invention of group I, claims 1-6 and 19-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

> The oath or declaration is defective because:
> It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Drawings

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

The disclosure is objected to because of the following informalities: on page 13, line 7 "altervacuum" should be changed to "alter vacuum," on page 16, line 9 "pump655" should be changed to "pump 655," and the term "receive" on page 19, line 1 should be changed to "receiver."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 20 and 21 contain the trademark/trade name MITYVAC. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe vacuum pumps, pressure pumps, various automotive tools, and vacuum extractor cups and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Watabe (abstract and machine translation).

With respect to Claim 1, Watabe teaches a method which comprises the steps of:

detecting a pressure in the vacuum device;

recording the pressure in the vacuum device; and

storing a record of the pressure in the vacuum device (see section of abstract entitled 'Constitution' for explanation).

With respect to Claim 2, Watabe teaches storing that is achieved mechanically (the device is mechanically coupled to the recorder –see section 0021 of the machine translation).

With respect to Claim 3, Watabe teaches storing that is achieved electronically (the data is electrically stored to both hard and floppy disks through a personal computer—see section 0021 of the machine translation).

With respect to Claim 19, Watabe teaches the steps of coupling the recording device to the vacuum device and recording the pressure so that a record may be produced therefrom (see Drawing 1 and sections 0021-0023 of the machine translation).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watabe.

Watabe teaches the step of generating a warning signal (alarm). --- See sections 0041 and 0042 of the machine translation. The Watabe abstract discloses that "the use of the vacuum is discriminated as good' when the vacuum pressure is lower than a preset value after a prescribed period has elapsed or as 'not good' when the pressure is higher than the preset value. "

It is unclear from the two references whether the alarm taught in the machine translation corresponds to the judgment of "not good" that is taught in the abstract of the disclosure (although it appears quite likely that they do correspond to one another).

However, at the time of the invention it would have been obvious to one having ordinary skill in the art at the time the invention was made to generate the warning signal when the "use of the vacuum" is discriminated as not good.

The suggestion/motivation for doing so would have been to provide an easy means for notifying a user of a leak in the vacuum chamber (the vacuum chamber is "not good").

Therefore, it would have been obvious to modify the Watabe reference to obtain the invention as specified in claim 4.

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watabe in view of Kouketsu.

Watabe does not explicitly teach the step of altering the pressure.

Kouketsu teaches the step of altering the pressure to achieve a second pressure (column 3, lines 33-62).

At the time of the invention it would have been obvious to one having ordinary skill in the art to add the step of altering the pressure to the method of Watabe et al.

The suggestion/motivation for doing so would have been to provide improved control for the operation of the vacuum device.

Therefore, it would have been obvious to combine the Kouketsu reference with Watabe in order to obtain the invention as specified in claim 5.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watabe in view of Oda et al.

Watabe does not disclose the step of releasing the pressure.

Oda et al. disclose the step of releasing the pressure (Fig. 7, step S20 and column 1, lines 28-53).

At the time of the invention it would have been obvious to one having ordinary skill in the art to add step of releasing the pressure to the method of Watabe et al.

The suggestion/motivation for doing so would be so that the vacuum chamber could be safely opened.

Therefore, it would have been obvious to combine the Oda et al. reference with Watabe to obtain the invention as specified in claim 6.

4. Claims 20 and 21 are rejected (as best understood in light of the 35 U.S.C. 112 rejection) under 35 U.S.C. 103(a) as being unpatentable over Watabe in view of *www.mityvac.com*.

Watabe does not disclose expressly a vacuum device that comprises a MITYVAC or a disposable MITYVAC.

The website www.mityvac.com discloses MITYVAC pumps that can be used to create a vacuum.

At the time of the invention it would have been obvious to one having ordinary skill in the art to add a MITYVAC pump to the system of Watabe et al.

The suggestion/motivation for doing so would have been to achieve a near perfect vacuum in the vacuum chamber.

Therefore, it would have been obvious to combine the *www.mityvac.com* reference with Watabe to obtain the invention as specified in claims 21 and 22.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Dimitriu et al. teach an obstetrical vacuum extractor cup with force measuring capabilities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacquelyn M. Myster whose telephone number is (703) 305-3343. The examiner can normally be reached Monday through Thursday 8:00 am to 5:30pm and alternate Fridays 7:30 am- 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John S. Hilten can be reached on (703) 308-0719. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308- 5841 for regular communications and (703) 308-5841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

jmm

September 9, 2002

JOHN S. HILTEN
SUPERVISORY PATENT EXAMINER
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